



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

Paper No.

JOEL E. LUTZKER, ESQ.  
SCHULTE ROTH & ZABEL LLP  
919 THIRD AVENUE  
New York, NY 10022

In re Application of  
Obara et al.  
Application No. 09/608,260  
Filed: June 30, 2000  
Attorney Docket No. 861975/32

In re Application of  
Obara et al.  
Application No. 09/887,695  
Filed: September 24, 2001  
For: ANTI-FRICTION BEARING

**COPY MAILED**

**FEB 14 2002**

**OFFICE OF PETITIONS**

DECISION GRANTING  
PETITION

This is a decision on petition under 37 CFR § 1.53(e),<sup>1</sup> filed October 30, 2001, requesting that an improper Continued Prosecution Application (CPA) under 37 CFR § 1.53(d) be treated as an application under 37 CFR § 1.53(b) and be accorded a filing date of September 24, 2001.

On March 22, 2001, a nonfinal Office action was mailed in application No. 09/608,260, which set a three (3) month shortened statutory period for reply. In response, on Monday, September 24, 2001, applicants submitted a petition for a three (3) month extension of time and a request for a CPA under 37 CFR § 1.53(d) based on prior application No. 09/608,260. However, CPA practice no longer applies to applications, other than design applications, if the prior application was filed on

---

<sup>1</sup>The instant petition is being treated as a petition under 37 CFR 1.53(e). Accordingly, the petition under 37 CFR 1.137(b), filed in the alternative, is dismissed as moot.

or after May 29, 2000.<sup>2</sup> Accordingly, the CPA request was improper because the prior application was filed on or after May 29, 2000.

In the event that an applicant files a request for a CPA of a utility or plant application that was filed on or after May 29, 2000 (to which CPA practice no longer applies), the Office will automatically treat the improper CPA as a request for continued examination of the prior application (identified in the request for CPA) under new 37 CFR § 1.114.

On September 27, 2001, a Notice of Abandonment was mailed. In this instance, prosecution was not closed because the last office action was nonfinal. Because the RCE was not accompanied by a reply, the time period set forth in the last Office action continued to run from the mail date of that action. Therefore, since the RCE was improper and the statutory period for reply expired, the application became abandoned.

On October 30, 2001, applicants filed the present petition. Applicants requested that the improper CPA be converted to an application under 37 CFR § 1.53(b). With the present petition, applicant submitted a complete copy of the prior application as filed, an amendment not previously entered in the prior application, an executed declaration, and an authorization to charge the necessary fees to counsel's Deposit Account.

The petition is granted.

The application under 37 CFR 1.53(b) has been assigned application No. 09/887,695 with a filing date of September 24, 2001. The CPA request, the present petition, the copy of the prior application, the declaration, and the amendment have been removed from the file of application No. 09/608,260 and have been placed in application No. 09/887,695. A copy of the CPA request and the present petition will be retained in application No. 09/608,260 to complete the record therein.

All further correspondence concerning the application under 37 CFR 1.53(b) should be directed to application No. 09/887,695 not application No. 09/608,260.

---

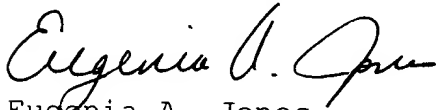
<sup>2</sup> Applicants filed Application No. 09/608,260 on June 30, 2000. Thus, 37 CFR 1.53(d)(1)(i) does not permit the filing of the CPA on September 24, 2001.

The Office finance records will be corrected to show that applicants paid the \$130.00 petition fee, \$168.00 claim fees, and the \$710.00 basic filing fee in application No. 09/887,695, not in application No. 09/608,260. Additionally, the \$1,280.00 petition fee to revive an application abandoned unintentionally, will be credited to Deposit Account No. 50-0675.

Application No. 09/608,260 will be forwarded to Files Repository.

Application No. 09/887,695 will be forwarded to the Office of Initial Patent Examination for processing as an application filed under 37 CFR 1.53(b), not under 37 CFR 1.53(d). **Additionally, the Office of Initial Patent Examination is directed to accord Application No. 09/887,695 a filing date of September 24, 2001, using the copy of the original application papers submitted on October 30, 2001.**

Telephone inquiries concerning this matter may be directed to Petitions Attorney Christina Tartera Donnell at (703)306-5589.



Eugenia A. Jones  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy

CTD